

Commissioner for Patents
December 8, 2005
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Serial No. 10/782,455
Art Unit: 2831 Examiner: Anton B. Harris
IBM Docket: AUS920031049US1(4037)

REMARKS

Claims 13-32 are pending, claims 25-32 stand restricted as being directed toward a different invention, and claims 13-24 stand rejected. Applicant respectfully suggests that the restrictions are unsupported and the rejections with respect to the claims are traversed in light of the following remarks.

Restriction of Claims 25-32

The Office action states that claims 25-32 are directed at a "materially different apparatus such as a television or transceiver". The Office action does not, however, point to any particular language of currently pending claims 13-24 that distinguish these claims from an "apparatus such as television or transceiver" or that support the conclusory statement that claims 25-32 read on an "apparatus such as television or transceiver". In fact, the Office action fails to present any support for the conclusion that the process of claims 25-32 is distinct from the apparatus or system as claimed in claims 13-24. Because Applicant considers this restriction a significant burden and the Office action offers no support for the restriction, Applicant requests reconsideration of the restriction.

Claim rejections under 35 USC § 102

Claims 13-24 stand rejected under 35 USC § 102(b) as being anticipated by Farrand, U.S. Patent Application No. 3,614,541 (hereinafter referred to as "Farrand"). Applicant respectfully suggests that the rejections with respect to previously presented independent claim 13 are traversed with the following remarks.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single reference.¹ Furthermore, the identical invention must be shown in as complete detail as is contained in the claim.²

With regards to claims 13-24, the Office action fails to establish a prima facie case of anticipation by Farrand for independent claims 13 and 21 because citations of Farrand provided

¹ *Verdegal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987).

² *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989).

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as support for the rejections fail to describe, suggest or teach "each and every element as set forth in the claim[s]".

In particular, for independent claim 13, the Office action (page 3, section 5, rejection of claim 13) states:

Farrand (abstract) discloses ... a pattern of interconnects 30 applied to an interior surface 8-11 of the hardware casing 7 ... the mounting sites 2 for mounting the components (col. 2, lines 38-32) to the interior surface 8-11....

Similarly, for independent claim 21, the Office action (page 4, section 5, rejection of claim 21) states:

Farrand (abstract) discloses ... a pattern of interconnects 30 applied to an interior surface 8-11 of the hardware casing 7 ... mounts 2 coupling the components (col. 2, lines 38-32) to the interior surface (abstract)

Farrand does not describe, expressly or inherently, "mounting the components ... to the interior surface...". Farrand describes mounting "integrated circuit components" on "module boards" or "boards", which are interconnected via wire patterns on the module boards and the circuits on both sides of the module boards are interconnected through the conducting strips on the inner sides of the housing (see col. 3, lines 38-47). In fact, Farrand even states that an object of the invention includes "provid[ing] a package in which circuits of modules are flexibly attached to the module boards to permit dimensional changes..." (see col. 1, lines 63-65). Thus, Farrand clearly does not anticipate "the mounting sites 2 for mounting the components (col. 2, lines 38-32) to the interior surface [of the hardware casing]". Applicant respectfully requests that the rejection of claims 13 and 21 be withdrawn and that claims 13 and 21 be allowed.

Further, claims 14-20 and 22-24 being dependent upon independent claims 13 and 21, respectively, incorporate the limitations of claims 13 and 21. Thus, Farrand does not teach all the limitations of dependent claims 14-20 and 22-24. Applicant respectfully requests that the rejection of dependent claims 14-20 and 22-24 be withdrawn and that dependent claims 14-20 and 22-24 be allowed.

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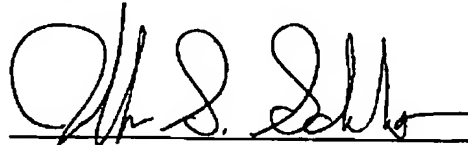
CONCLUSION

Applicant respectfully traverses the cited reference in regards to the claim rejections of claims 13-24 under 35 USC § 102. Accordingly, Applicant believes that this response constitutes a complete response to each of the issues raised in the Office action. In light of the accompanying remarks, Applicant believes that the pending claims are in condition for allowance. Thus, Applicant requests that the rejections be withdrawn, pending claims be allowed, and application advance toward issuance. If the Examiner has any questions, comments, or suggestions, the undersigned attorney would welcome and encourage a telephone conference at (512) 288-6635.

No fee is believed due with this paper. However, if any fee is determined to be required, the Office is authorized to charge Deposit Account 50-3295 for any such required fee.

Respectfully submitted,

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Date



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